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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/915,838  
Filing Date: July 26, 2001  
Appellant(s): JANAKIRAMAN ET AL.

**MAILED**

**JUL 23 2007**

**GROUP 3600**

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Robert H. Frantz  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 4, 2007 appealing from the Office  
action mailed November 3, 2006.

**(1) Real Party in Interest**

- A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

- The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

- The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

- The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

- The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

- The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

- The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

- 6,327,574      Kramer et al.      12-2001

**(9) Grounds of Rejection**

- The following ground(s) of rejection are applicable to the appealed claims:

***Rejection of Claims 21-29 under 35 USC § 112***

- The amendment filed on August 18, 2006 failed to correct the second paragraph of 35 U.S.C. 112 deficiencies identified in the Office Action dated May 18, 2006. Therefore, the rejection is maintained. The disclosed data object selector and composite advertisement object render merely disclose what there intended functions are and do not disclose that they are operable together. The examiner suggests removing the term “for” used throughout the claim and rewrite the claims to indicate the actual interactions between the various components that occur within the claimed system.
- Copy of Rejection in Office Action dated May 18, 2006: Claims 21 – 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant has disclosed only a system containing various data and data objects, but provides no express, implied or inherent disclosure regarding the structure and function of the system claimed. Therefore, the examiner is unable to determine the type of system, which the applicant considers as his/her invention.

***Rejection of Claims 21-29 under 35 USC § 101***

- The amendment filed on August 18, 2006 failed to correct the 35 U.S.C. 101 deficiencies identified in the Office Action dated May 18, 2006.  
  
Therefore, the rejection is maintained. The claimed components do not function to produce a tangible output because they are not claimed as functioning together. Instead, the claim merely discloses that the various components are intended to function together. The claims do not require that any functionality is present just that the capability of functioning once the components are assembled is claimed. The examiner suggests removing the term “for” used throughout the claim and rewrite the claims to indicate the actual interactions between the various components that occur within the claimed system. For a more precise example please refer to the Office Action dated May 18, 2006.
- Copy of Rejection in Office Action dated May 18, 2006: Claims 21 – 29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Data and data objects on system, that contains no structure and performs no functions, is considered to be the equivalent data on a disk which is non-functional descriptive material (See MPEP 2106(IV)(B)1(b)). In order to meet the 35 USC 101 requirements the claimed invention must produce a “useful, concrete, and tangible result”, and the invention as currently claimed is not capable of meeting these requirements. In order to correct this deficiency the examiner

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suggests that the applicant amend the claim to distinctly point out the structure of the system and how it interacts with the claimed data objects to produce a useful, concrete and tangible result.

For example, the applicant may be intending to claim a computer program on a computing device causing a computer processor to execute the steps consisting of:

- a. Searching two or more data object repositories...
- b. Selecting two or more data objects...
- c. Producing a composite advertisement...
- d. Displaying a composite advertisement...

***Rejection of Claims 1-29 under 35 USC § 102***

- Claims 1 – 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Kramer et al. (U.S. Patent Number: 6,327,574).

Claim 1. Kramer discloses a method for dynamically generating targeted electronic advertisements comprising the steps of:

- a. Providing two or more data object repositories, said data object repositories containing a plurality of data objects indexed to target audience characteristics, at least one of said repositories containing depictions of a plurality of human models indexed by demographic

- characteristics of the human models. (Fig 3b, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)
- b. Selecting two or more data objects from said data object repositories based upon a given set of instant user characteristics, at least one of said data objects comprising a depiction of a human model having matching demographic characteristics (Fig 3b, Fig 18, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)
  - c. Producing a composite advertisement object by combining said selected data objects to render a single advertisement data object. (Fig 3b, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)
  - d. Providing for consumption said composite advertisement object to said instant user. (Fig 3b, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)

Claim 2. Kramer discloses the method as set forth in claim 1 wherein said step of selecting further comprises pseudo-randomly selecting a data objects. (Col 3, lines 10 – 33; Col 21, lines 20 – 31; and Col 21, lines 51 – 61) (Pseudo-randomness is an inherent quality of targeted marketing because demographics and psychographics are unique for each individual)

Claim 3. Kramer discloses the method as set forth in claim 1 wherein said

human model depictions comprise depictions selected from the group of a still graphic image repository, a video clip repository, and an audio clip repository. (Fig 18, Col 6, lines 22 – 46)

Claim 4. Kramer discloses the method as set forth in claim 1 wherein said step of providing two or more data object repositories comprises providing an advertising message repository. (Col 7, lines 16 – 44; and Col 11, lines 55 – 67)

Claim 5. Kramer discloses the method as set forth in claim 4 wherein said step of providing an advertising message repository is selected from the group consisting of providing a still graphic image repository, providing a video clip repository, providing a web page repository, and providing an audio clip repository. (Col 6, lines 22 – 46)

Claim 6. Kramer discloses the method as set forth in claim 1 wherein said step of selecting two or more data objects from said data object repositories based upon a given set of instant user characteristics comprises selecting data objects based upon instant user demographic factors. (Col 14, lines 11 – 34)

Claim 7. Kramer discloses the method as set forth in claim 1 wherein said



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step of selecting two or more data objects from said data object repositories based upon a given set of instant user characteristics comprises selecting data objects based upon historical advertising effectiveness trend data. (Col 14, lines 11 – 34)

Claim 8. Kramer discloses the method as set forth in claim 1 wherein said step of producing a composite advertisement object is selected from the group consisting of overlaying one still graphic image data object over another, merging a video clip with an audio clip, and merging a plurality of video clips. (Col 6, lines 22 – 46)

Claim 9. Kramer discloses the method as set forth in claim 1 wherein said step of providing for consumption a composite advertisement object to an instant user is selected from the group consisting of transmitting said composite advertisement object over a computer network, displaying said composite advertisement, and playing said composite advertisement. (Col 8, lines 41 – 54)

Claim 10. Kramer discloses the method as set forth in claim 7 further comprising a step of updating said historical advertising effectiveness trend data according to subsequent instant user selection of options related to said composite advertisement object. (Col 14, lines 35 – 51)

Claim 11. Kramer discloses a computer readable medium encoded with software for dynamically generating targeted electronic advertisements comprising, said software when executed causing a computer to perform the steps of:

- a. Provide two or more data object repositories, said data object repositories containing a plurality of data objects indexed to target audience characteristics, at least one of said repositories containing depictions of a plurality of human models indexed by demographic characteristics of the human models. (Fig 3b, Fig 18, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)
- b. Select two or more data objects from said data object repositories based upon a given set of instant user characteristics, at least one of said data objects comprising a depiction of a human model having matching demographic characteristics. (Fig 3b, Fig 18, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)
- c. Produce a composite advertisement object by combining said selected data objects to render a single advertisement data object. (Fig 3b, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)
- d. Provide for consumption said composite advertisement object to said instant user. (Fig 3b, Col 6, line 60 to Col 7, line 44; and Col 18, lines

38 – 42)

Claim 12. Kramer discloses the computer readable medium as set forth in claim 11 wherein said software for selecting further comprises pseudo-randomly selecting a data object. (Col 3, lines 10 – 33; Col 21, lines 20 – 31; and Col 21, lines 51 – 61) (Pseudo-randomness is an inherent quality of targeted marketing because demographics and psychographics are unique for each individual)

Claim 13. Kramer discloses the computer readable medium as set forth in claim 11 wherein said software for providing a human model repository is adapted to provide repository objects selected from the group consisting of a graphic image, a video clip, and an audio clip. (Col 6, lines 22 – 46)

Claim 14. Kramer discloses the computer readable medium as set forth in claim 11 wherein said software for providing two or more data object repositories comprises providing an advertising message repository. (Col 7, lines 16 – 44; and Col 11, lines 55 – 67)

Claim 15. Kramer discloses the computer readable medium as set forth in claim 14 wherein said software for providing an advertising message repository is adapted to provide repository objects selected from the group

consisting of a still graphic image, a video clip, a web page, and an audio clip. (Col 6, lines 22 – 46)

Claim 16. Kramer discloses the computer readable medium as set forth in claim 11 wherein said software for selecting two or more data objects comprises software for selecting data objects based upon instant user demographic factors. (Col 14, lines 11 – 34)

Claim 17. Kramer discloses the computer readable medium as set forth in claim 11 wherein said software for selecting two or more data objects comprises software for selecting data objects based upon historical advertising effectiveness trend data. (Col 14, lines 11 – 34)

Claim 18. Kramer discloses the computer readable medium as set forth in claim 11 wherein said software for producing a composite advertisement object is adapted to perform a composite advertisement selected from the group consisting of a still graphic image overlaid on another still graphic image, a video clip merged with an audio clip, and a plurality of video clips merged together. (Col 6, lines 22 – 46)

Claim 19. Kramer discloses the computer readable medium as set forth in claim 11 wherein said software for providing for consumption a composite

advertisement object to an instant user is adapted to use a method selected from the group consisting of transmitting said composite advertisement object over a computer network, displaying said composite advertisement, and playing said composite advertisement. (Col 8, lines 41 – 54)

Claim 20. Kramer discloses the computer readable medium as set forth in claim 17 further comprising software for updating said historical advertising effectiveness trend data according to subsequent instant user selection of options related to said composite advertisement object. (Col 14, lines 35 – 51)

Claim 21. Kramer discloses a system for dynamically generating targeted electronic advertisements comprising:

- a. Two or more data object repositories, said data object repositories containing a plurality of data objects indexed to target audience characteristics, at least one of said repositories containing depictions of a plurality of human models indexed by demographic characteristics of the human models. (Fig 3b, Fig 18, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)
- b. A data object selector for selecting two or more data objects from said data object repositories based upon a given set of instant user

- characteristics, at least one of said data objects comprising a depiction of a human model having matching demographic characteristics. (Fig 3b, Fig 18, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)
- c. A composite advertisement object renderer for combining said selected data objects to render a single advertisement data object. (Fig 3b, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)
- d. A rendered composite advertisement object provided for consumption to a to said instant user. (Fig 3b, Col 6, line 60 to Col 7, line 44; and Col 18, lines 38 – 42)

Claim 22. Kramer discloses the system as set forth in claim 21 wherein said software for selecting further comprises pseudo-randomly selecting a data object. (Col 3, lines 10 – 33; Col 21, lines 20 – 31; and Col 21, lines 51 – 61) (Pseudo-randomness is an inherent quality of targeted marketing because demographics and psychographics are unique for each individual)

Claim 23. Kramer discloses the system as set forth in claim 22 wherein said human model repository includes a data object selected from the group consisting of still graphic images, video clips, and audio clips. (Col 6, lines 22 – 46)

Claim 24. Kramer discloses the system as set forth in claim 21 wherein said data object repositories comprise an advertising message repository. (Col 7, lines 16 – 44; and Col 11, lines 55 – 67)

Claim 25. Kramer discloses the system as set forth in claim 24 wherein said advertising message repository includes a data object selected from the group consisting of still graphic images, video clips, web pages, and audio clips. (Col 6, lines 22 – 46)

Claim 26. Kramer discloses the system as set forth in claim 21 wherein said data objects selector is adapted to select data objects from said data object repositories based upon instant user demographic factors. (Col 14, lines 11 – 34)

Claim 27. Kramer discloses the system as set forth in claim 21 wherein said data objects selector is adapted to select data objects based upon historical advertising effectiveness trend data. (Col 14, lines 11 – 34)

Claim 28. Kramer discloses the system as set forth in claim 21 wherein said composite advertisement object renderer is adapted to produce a composite advertisement object selected from the group consisting of two overlaid still graphic images, a merged video clip and audio clip, and a

merged plurality of video clips. (Col 6, lines 22 – 46)

Claim 29. Kramer discloses the system as set forth in claim 21 further comprising a historical data updater for updating said historical advertising effectiveness trend data according to subsequent instant user selection of options related to said composite advertisement object. (Col 14, lines 35 – 51)

#### **(10) Response to Argument**

##### **Re. Rejection of Claims 21-29 under 35 USC § 112**

- The applicants argue that Claim 21 specifically recites the functions and structural relationship of four system components. The examiner agrees that the intended use (intended function) and structure of four distinct components are recited but the components are not claimed as functioning together to produce a result. The applicant has claimed two data bases that contain data, which is considered non-functional descriptive material; a data object selector and a composite advertisement object renderer both of which, based upon the applicants specification, are software modules and therefore are considered functional descriptive material; and an advertisement which is considered printed matter. Claim 21 never provides any indication that the system and its components are operating and/or operated to produce the advertisement. One of ordinary



skill in the art of computer programming would realize that the concept behind utilizing modules in a program is that each module is directed towards accomplishing a specific function in the program. This allows for the code in the separate modules to be changed or updated without affecting the functionality of the other modules within the program, it also allows for the modules to be reused in other programs. The fact that a modules purpose is "for selecting two or more data object" or "for combining said selected data objects" does not indicate that the two modules are operating together in a program. It merely indicates that these are there intended uses. As the examiner suggested in the Office Action dated May 18, 2006 the applicant needs to claim the interaction between the modules in order for the system to function. As an example, rather than claiming a data object selector "for" selecting two or more data objects which is merely a recitation of the intended use, the claim needs to indicate "a data object selector that selects two or more data objects from said data object" or "a computer program that performs the step of selecting two or more data objects from said data object repositories". Without claiming such interaction the claim is directed towards two components that are considered non-functional descriptive material (an advertisement and two databases) and two components that are considered functional descriptive material (a data object selector, and a composite advertisement image renderer).

**Re. Rejection of Claims 21-29 under 35 USC § 101**

- Regarding arguments directed towards the applicants contention that the claims describe functionality, please refer to the foregoing response to arguments with reference to Re. Rejection of Claims 21-29 under 35 USC §112.
- Regarding the applicant argument that Claim 21 produces a tangible result, the claim merely recites that the system contains a rendered composite advertisement. The claim does not require that the composite advertisement renderer produced the rendered composite advertisement. There is no indication in the claim that the "single advertisement data object" that the composite advertisement object renderer is intended to be able to create, and the "rendered composite advertisement" are the same objects. The applicant must claim that the interactions of the various components were used to create the rendered composite advertisement object. Instead, as currently claimed, the rendered composite advertisement objects is merely one of the components of the claimed system and not an output produced by the system.

**Re. Rejection of Claims 1-29 under 35 USC § 102**

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- Regarding the applicant's argument that Kramer does not disclose a data repository that contains human models, the examiner has provided specific quotes from the Kramer reference as applied to the limitation provided by the independent claims. The specific quotes are not the only support in Kramer for teaching each individual limitation but are intended to be exemplary in nature.

Kramer teaches providing two or more data object (illumination) repositories in Col 18, lines 38-42 (where he recites:

"Since illuminations are implemented as URLs, any website can be a server G for illuminations for illuminated pages. The page illuminator N simply substitutes the appropriate HTML text. The Internet browser X then embeds the content automatically in the displayed document")

Kramer teaches that said data object repositories are indexed to targeted audience characteristics in Col 7 lines 4-8 and 21-28 (where he recites:

"The selection of which second merchant's icon 308 to include in the transaction is based on the consumer's profile which is used to select one of a number of variable content alternatives that are

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encoded in the credit card statement when it is received electronically."

And

"The selection of which merchant's coupons to include in the illuminated transaction are again based on the profile of the consumer and the attributes of each selectable content alternative that is encoded in the statement for this transaction. Thus, different consumers having a transaction with the same merchant may receive entirely different coupons 312 or co-branding icons 308 because of differences in their personal consumer profiles.")

Kramer teaches that at least one of said repositories contains human models in Fig. 18 (where the figure of a human model that polymorphs into a rat is chosen as the illumination to display)

Kramer teaches that these repositories containing human models are indexed by demographic characteristics of the human models in Col 32, line 67 through Col 33, line 47 (where he teaches that:

" When the consumer clicks on the content item 1408  
("Top 20 List of best selling books for your

child"), the merchant's server receives an explicit request for children's books. This request is then used to select a more specific set of potential illuminations to send to the consumer's computer. In effect, the merchant is now aware of the consumer's interest in children's books (as this information has been volunteered by the consumer when he clicked on the content item 1408), but still does not know which sub-category of children is appropriate. Thus, the second set of candidate illuminations is directed to specific sub-categories within the children category (infant/preschool, young school age, middle schoolers, and high schoolers), and includes target vectors 1036 containing attributes corresponding to these specific sub-categories. The relevancy vectors 1038 is also set to restrict interest to only these attributes.")

Kramer teaches selecting two or more data objects from said repository with at least one of the selected data objects comprises a depiction of a human model having matching demographic characteristics in Fig 17; Fig 18 and Col 32, line 67 through Col 33, line 47 (where he teaches that:

"Using this second set of illuminations, the Illumination Sorter 816 now matches these target vectors 1036 to the consumer's attribute vector 808. The infant/preschool category is found to have the highest match with the consumer's attribute vector, and the content shown in FIG. 17 is displayed, here as a separate window, instead of in the statement line.

A second consumer, in a different household may see the same content 1408 on his statement, and may also click on it. But in that consumer's lower level attribute vector 808, the "young school age" sub-category may be the best match, so the content which is displayed from all the conditional illuminations is different, as shown in FIG. 18."

Kramer teaches producing and providing for consumption a composite advertisement by combining selected data objects in Fig 3a, Fig. 3b, Fig. 17 and Fig 18 where it can be seen a composite image (web page) consisting of multiple advertising images. Fig 18 teaches that these advertising images can include human models.

- Additionally the applicants contend that their invention sets forth selection of images or movies which feature “human models” that correspond to demographic characteristics of the viewer of the produced advertisement, and that Kramer lacks this distinction. However, this is precisely what Kramer is disclosing in Fig 18 and Col 7, lines 3-7 (quoted previously) where the selection of an illumination (advertisement) is based upon the customer profile.
- The applicant also tries to distinguish the consumer model of Kramer, which is mathematically based, with the human model of the instant application. Such a distinction is mute since Fig 18 of the Kramer reference contains a “human model”.
- The applicant contends that Kramer is silent regarding selecting images of human models which match the user’s ethnic, economic, age familial or other demographic characteristics but later admits on page 11, lines 2-4 of the Appeal Brief that “Kramer discloses that the Animorph book is selected because the user is known to be a child, and the book is of the type and character which interests children”. Since age is a demographic characteristic and the Animorph book cover contains a human image, the meets and bounds of the disputed limitation have been met.
- The applicant argues that Kramer is silent regarding the merging of two images to product the final book cover image. The examiner agrees that

the Kramer reference does not specifically state that one can create the human model book cover by merging the photo of the human object with the photo of the book. However, the claim limitations do not require such teachings. One can see from figure 18, that an advertisement image was created for "The Top 20 Bestselling Children's Books" by merging images from at least three different books into a single advertisement image. The most stringent "merging" that is indicated by the applicant's claims can be found in Claim 8, which requires that the merging is accomplished by overlaying one image over another. Fig. 3a and 3b. of Kramer disclose such a merging. The original image is a text based image as depicted in figure 3a. Then Kramer illuminates the text based image by overlaying more graphically pleasing images on the original image. The process of obtaining the advertisement depicted in 3b from the original text based image is describe in further detail in Col 6, line 47 through Col 7, line 44 and Kramer specifically states that the process of illumination "can be applied to any type of structured document generally so long as it is formatted with the information describing the selectable content alternatives" in Col 7, lines 45-49.

**(11) Related Proceeding(s) Appendix**



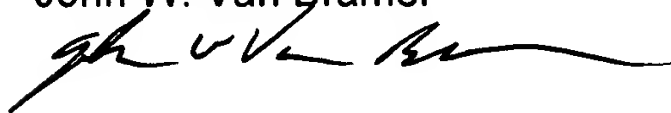
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- No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John W. Van Bramer

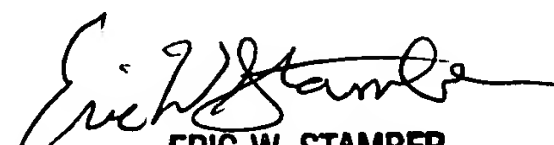
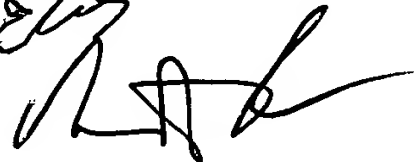


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